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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,129	12/06/2000	John A. Pacey	1116-008/JRD	9598

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EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 11/30/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/732,129

Applicant(s)

JOHN A. PACEY

Examiner

Teena K Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the locking lever arm must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- In figures 2 and 5, the 45° angle.
- Arm 22 not shown in Figs. 7, 8, 11.
- Transmitter 220.
- Angle 208 not shown in Figs. 9 and 10.
- Elongate arm 22 not shown in Figs. 9 and 10.

Correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 212, 207, 110, and 46. Correction is required.

Specification

The disclosure is objected to because of the following informalities:

- The use of acronym's CCD, CMOS, and LED.
- Page 8, line 11, "...if..." should be amended to read --in--.
- Page 7, "...body 20..." then on page 8, "...instrument 20..." reference element 20 should be labeled consistently throughout the specification.
- Page 16, line 2, "...base portion 2020..." should be amended to read --202--.
- Page 16, line 11, "...lifter portion 202..." should be amended to read --204--.
- Page 19, line 9, "...lifter portion 208..." should be amended to read --lifter portion 204--. Correction is required.

Claim Objections

Claims 4, 10, 11, 21, 22, 24, and 29 are objected to because of the following informalities: The use of acronym's CMOS, CCD, and LED. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 19, and 25, "...a distal end..." is indefinite; it is unclear as to what element has a distal end (i.e. elongate arm, the elongate base portion, or the elongate lifter).

Claim 26 recites the limitation "...the middle of said elongate arm..." in line 2. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6-9, 16-18, 19, and 20 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 14 of U.S. Patent No. 6,142,144. Although the conflicting claims are not identical, they are not patentably distinct from each other because the mere omission of an element and its function (e.g. in claims 1, 19, and 25 use of the term elongate (i.e. arm, base portion, lifter portion; said lifter portion being at least 3 centimeters long and extending from said base portion by at least a 5 degree angle; said lifter portion being as long as said base

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portion) is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136, USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969).

Claim Rejections - 35 USC § 103

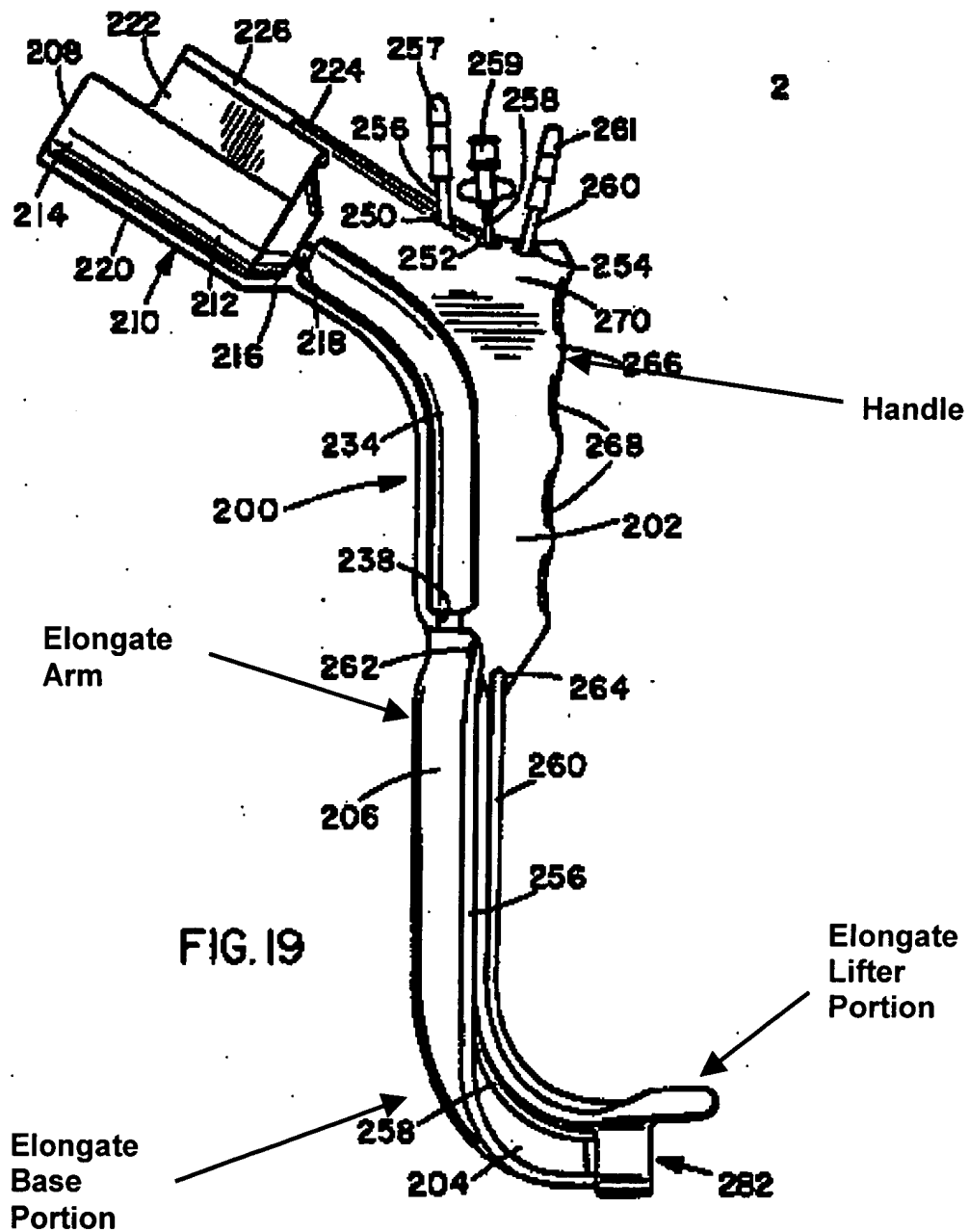
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 16-22, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Augustine (5,203,320) in view of MacAllister (5,016,614).

Augustine in an intubation instrument discloses:

- a body (see Fig. 23 illustrated below) having a handle (200, 266) attached thereto;
- an elongate arm (see Fig. 23, illustrated below) having an elongate base portion attached to the body and,
- an elongate lifter (Fig. 23, below) said lifter portion being at least 3 centimeters long and extending from said base portion by at least a 5 degree angle (Fig. 23)



With respect to claim 2, Augustine discloses a viewer (297) positioned in the vicinity of the area where the base portion meets the lifter portion of the arm, said viewer directed toward the distal end of the lifter portion.

The difference between Augustine and claim 3 is the viewer being a telescope.

MacAllister in an intubation instrument teaches various medical visualization scopes sometimes called telescopes can also be employed (Col. 5, lines 5-10).

It would have been obvious to modify the viewer of Augustine to employ any well known viewer including the viewer taught by MacAllister as mere substitutions one well known viewer for another.

Claims 4, 5, 19-22, 25, and 27 are equivalent in scope to claims 1-3 discussed above and are included in Augustine modified by MacAllister.

With respect to claim 6, Augustine discloses the claimed invention except for wherein said at least 5° angle is between 5° and 85°, inclusive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the at least 5° angle is between 5° and 85°, inclusive, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art absent persuasive evidence that a particular angle renders an unexpected result. (In re Aller, 105 USPQ 233.

Claims 7, 8, and 16-18 are equivalent in scope to claim 6 discussed above and are included in Augustine.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show intubation instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena K Mitchell whose telephone number is (703) 308-4016. The examiner can normally be reached on Monday-Friday.

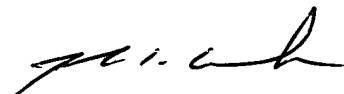
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

TKM

TKM

November 18, 2001



John G. Weiss
Supervisory Patent Examiner
Group 3700